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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hyeong Min AHN et al.

Application No.: 10/790,791

Group Art Unit: 2873

Confirmation No.: 4385

Filed: March 3, 2004

Examiner: Joseph P. Martinez

For: OPTICAL SYSTEM WITH IMAGE PRODUCING SURFACE CONTROL
UNIT

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Alexandria, Virginia 22313

Sir:

In response to the Office Action mailed on March 27, 2006, Applicants provisionally elect Group I, directed to claims 1-10 with traverse.

The restriction requirement is improper for the following reasons.

First, Group I, directed to claim 1-10, and Group II, directed to claim 11-27 are not distinct since the inventions defined in Groups I and II are classified in the same class 359 and are in the same field of search for the same subject matter as an image surface to be disposed with respect to a lens. With respect to subclass or the field of search, the Examiner appears to regard Group II as an optical system wherein an image surface of the lens is inclined with respect to an optical axis. However, Group II does not relate to an image surface of the lens, but relates to the same subject of an image surface disposed with respect to an optical axis of the lens. In addition, class 359, subclass 290 relates to "changing physical characteristics of an optical element," and class 359, subclass 822 relates to "a parameter of the lens." It is respectfully submitted that Groups I and II does not relate to the parameter of the lens set forth in class 359, subclass 822, and that the field of search for Group I is the same as Group II since Groups I and II relate to the same image surface to be disposed with respect to a lens. Therefore, since there is no serious burden, Groups I and II are not distinct according to MPEP §§803 and 808.02.

Second, Group I and Group II are not distinct since the combination requires particulars of the sub-combination when Group I is referred to as the combination and Group is referred to as the sub-combination. It is respectfully submitted that an operation

of controlling of the image surface to move with respect to the lens, as defined in Group I, includes a state where the image surface is inclined with respect to the lens, as defined in Group II. However, according to the Examiner assertion that the products as claimed encompass embodiments that are not required to control the image producing surface with respect to the lens, the Examiner appears to refer to Group II as the combination and Group II as the sub-combination. Accordingly, the Examiner's assertion seems to contradict the criteria of distinctness for combination, sub-combination, or element of a combination according to MPEP §806.05(c). Therefore, since Groups I and II are not distinct, the restriction is never proper according to the criteria for the restriction set forth in MPEP §806.05.


Upon review of the issues involved in the distinctness of the inventions and the criteria for the restriction references, it is believed that upon consideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

Should any questions remain unsolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

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